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EXAMINER

POLLACK, MELVIN H

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2145

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,723

Applicant(s)

YOSHIZAWA, HIROYUKI

Examiner

Melvin H Pollack

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 21 July 2004 have been fully considered but they are not persuasive. A point-by-point rebuttal will be given within this section.
2. The examiner withdraws the objection to the title and accepts the new title.
3. The examiner withdraws the objection to the abstract and accepts the new abstract.
4. The examiner withdraws the 112 rejection regarding claim 3, on the grounds that claim 3 has been properly cancelled.
5. The examiner maintains the 112 rejection regarding claims 1, 11, and 21-28 that the "error is within a predetermined range" issue. The examiner understands better the concept that the applicant is attempting to get across, but still has issue regarding the term "range." The Fifth Edition of the Microsoft Computer dictionary defines a range as "the spread between specified low and high values" and a range check as "a limit check of both the upper and lower limits of a value." Further, the term "error" is not yet fully defined in the specification, and there is confusion regarding the issue. The phrase could mean that the message is transmitted for certain error types but not for others, i.e. a message is not sent for communications errors, but it is sent for a less potent error. Alternatively, the phrase could mean that the differences between the two pictures is converted to a number that the applicant is calling the error, and that the action occurs only if this number is below a certain predefined threshold. Clarity on this matter is needed to advance prosecution of the case.
6. The examiner has determined that the usage of "and/or" is acceptable, and therefore withdraws the prior rejection on the grounds that the language is clear and properly reflects the

Art Unit: 2141

embodiments of the specification. It should be noted, however, that the allowance of this term in other applications, including those allowed previously by the applicant, is not de facto evidence that such terms must be allowed in subsequent cases.

7. Regarding the 112 rejection of claims 1, 11, and 21-28 regarding omitted elements, the examiner is withdrawing and then reinstating the rejection for the purpose of clarifying issues. First of all, the examiner apologizes for the term “lousy authentication device,” and for any distress felt by the applicant and related parties. The purpose of the term was not to insult the applicant or the applicant’s invention, but rather a poor choice of terms to reflect the confusion of the examiner regarding the issue at hand. Second of all, the examiner acknowledges that various discussions regarding the claim language has muddled the issue, and therefore made it difficult for the applicant to properly respond. The new rejection should be cured of all defects from the original rejection.

8. In response to applicant's argument that the “definiteness of the language employed in the claims must be analyzed – not in a vacuum, but always in light of the teachings of the particular application disclosure,” the examiner notes that “functional features recited in the independent claims are definite and should be interpreted in light of the Specification” does not always apply. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. In response to the 103 rejections for all claims, the examiner maintains the rejections.

10. Regarding the applicant’s allegations that Glass does not expressly disclose the issue of the error within a certain range, it has been shown above that the meaning is unclear and must be

Art Unit: 2141

clarified. That said, using the definition that the examiner has suggested above, it should be clear that Glass does in fact teach this limitation. Specifically, Fig. 2 clearly shows that the image (Fig. 2, Scene) is transmitted to a matcher (Fig. 2, #10) that compares the converted image to those located in a template store (col. 6, line 40 – col. 7, line 5). As shown, an event is triggered – an access to the secured resource – only if the images match, our definition of error falling between a certain range (col. 9, lines 50-60). Glass teaches the necessity of “identifying a person seeking to enter a secured location, use a computer system or perform a financial or other transaction (col. 1, lines 10-15) and describes secure resource accessing as “allowing data or access to services (col. 8, lines 55-60).” As stated above, Uomini teaches the e-mail system environment, which we will discuss further.

11. Regarding the usage of “official notice,” the examiner has stated before that the Applicant must provide more than a “bald challenge.” Specifically, the applicant has failed to provide information regarding whether the official notice regarding whether a restricted service may be e-mail. One of ordinary skill in the art would recognize that e-mail systems routinely use authentication systems such as passwords, and thus would be considered a restricted resource. Therefore, one of ordinary skill in the art would unquestionably know that e-mail is a restricted resource to which the biometric method of Glass may be considered as applicable, and the official notice is valid.

12. Nevertheless, the examiner notes that Uomini teaches a method (abstract) of secure e-mail in which the sender’s identity information is studied (col. 5, lines 5-15). Sundsted also teaches methods (abstract) of using e-mail as a secured resource, as did previously cited examples that are well known to one of ordinary skill in the art. Further, Uomini teaches the

Art Unit: 2141

usage of e-mail to perform electronic shopping (Fig. 2) and Glass teaches that various forms of electronic shopping are considered an example of secure resources (col. 8, lines 30-33).

Therefore, the examiner's usage of official notice stands.

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary goal of Glass is to not only connect biometric abilities to a home desktop computer (col. 3, lines 30-45) but to also provide a variety of methods to avoid fraud by manipulation of images (col. 2, lines 10-35) to provide undetectable substitution or tampering (col. 2, lines 58-60). Uomini teaches that a method of doing so can be a variety of "context" information methods attached to the bottom of an email address in order to strengthen the authentication process for the purpose of recipient knowledge (col. 2, lines 15-30). Sundsted

Art Unit: 2141

teaches the strengthening of authentication processes in order to correctly charge senders a proper fee (col. 7, lines 55-65). As such, the purpose of all three sources is to provide stronger authentication methods, and therefore it would have been obvious to one of ordinary skill in the art to combine them.

15. For the reasons above, the rejection stands.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1, 11, and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “only when an error, between the image information and prestored image information, is within a predetermined range” in claims 1, 11, and 21-28 is viewed by the examiner to mean “the difference between the two images, represented as a differential value, lies below a certain predetermined threshold”, while the accepted meaning is “one or both of the images leads to an error message which is then compared to a range of values to determine the proper response to the error message.” The term is indefinite because the specification does not clearly redefine the

Art Unit: 2141

term. Clarification on this issue is required. For the purposes of examination, the examiner assumes the former definition. If the examiner is correct, then the applicant is recommended to consider language similar to that of the examiner's definition above, or at least to use terms that reflect the meaning more clearly than "error" and "range."

19. Claims 1, 11, and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the formation of the electronic signature file. One of ordinary skill in the art generally considers an electronic signature file to be unchanging unless a user opens and modifies the file, and the art currently cited generally reflects this view. The purpose of the invention, as the examiner understands it, is to provide authentication of the current user. Therefore, the applicant should clarify if the image information is included within an electronic signature file at the time that the user composes the message and/or presses the send button, and therefore the signature file changes from message to message by a certain amount, wherein the message is sent only if the changes are considered minute. The examiner also suggests a clarification regarding the image generator and method of generating the image. The examiner believes that exploration of this issue may result in advancement of the prosecution of this case.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2141

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1, 2, 4, 10-12, 20, 23, 24, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glass et al. (6,332,193) in view of Uomini (6,018,761).

22. For claim 1, Glass teaches an electronic apparatus (abstract) comprising a transmitter (Fig. 2, #4) transmitting electronic message signals (Fig. 7, #17) in which a symbol including image information (Fig. 2, #6), which enables a sender to be specified therefrom (col. 1, lines 10-20), is included within an electronic signature file (col. 5, line 65 – col. 6, line 9), wherein said transmitter allows resource access and activities to occur only when an error, between the image information and prestored image information, is within a predetermined range (col. 1, lines 40-47; col. 9, lines 50-55). For the purposes of examination, the examiner assumes that the final phrase means that access and activities are triggered only if the recent picture matches a pre-saved template to an acceptable degree, as Glass teaches in the cited areas above.

23. Glass teaches that the purpose is to secure access to various types of secured resources, but does not expressly disclose that electronic mail is considered to be included within the group of secured resources. Examiner takes Official Notice (see MPEP § 2144.03) that “one of these resources is electronic mail” in a computer networking environment was well known in the art at the time the invention was made. There is a large body of art devoted to ensuring that the sender of a message is who he claims to be, using a wide variety of authentication schemes. One example would be an electronic stamp method, while another would be an ISP and header filter. Further, Glass teaches a method of internet shopping (col. 8, lines 30-33), in which one may make a purchase through a simple e-mail. At the time the invention was made, one of ordinary

Art Unit: 2141

skill in the art would have studied the Glass biometric system as a way to secure e-mail access as a replacement for passwords and other authentication schemes.

24. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

25. Glass does not expressly disclose that the image is included within an electronic signature file of the electronic mail, said electronic signature file including an email address of the sender. Uomini teaches a method (see abstract) of studying e-mails for further context, in which signatures of various types are analyzed (see background section), and said content can include both images and e-mail addresses (col. 5, lines 1-20). At the time the invention was made, one of ordinary skill in the art would have combined the two inventions in order to better develop a digital signature that would be harder to manipulate (Glass, col. 7, line 65 – col. 8, line 13).

26. For claim 2, Glass teaches a generator generating the image information by inputting an image of the sender (Fig. 2, #6).

27. For claim 4, Glass teaches that the image information includes an image related to at least a face of the sender (Fig. 2, Scene). In this embodiment, Glass teaches that the image is of an eye, for retinal scanning, and the eye is related to the face of the sender. Further, it is well known in the art that some biometric methods use an image of the entire face or body.

28. For claim 10, Glass does not expressly disclose that the symbol includes information affording linking to the sender. Uomini teaches this limitation (Fig. 2b). At the time the invention was made, one of ordinary skill in the art would include this information so that the receiver could recognize the sender (col. 1, lines 45-50) and so that the recipient can gain valuable information regarding whether to do business with the sender (col. 2, lines 18-25).

29. Claim 11 drawn to the limitations in claim 1. Claim 11 adds a display, which Glass also teaches (Fig. 7, #2). Therefore, since claim 1 is rejected, claim 11 is also rejected for the reasons above.

30. Claim 12 is drawn to the limitations in claim 4. Therefore, since claim 4 is rejected, claim 12 is also rejected for the reasons above.

31. Claim 20 is drawn to the limitations in claim 10. Therefore, since claim 10 is rejected, claim 20 is also rejected for the reasons above.

32. Claims 23 and 24 are drawn to the limitations in claims 1 and 11, respectively. Therefore, since claims 1 and 11 are rejected, claims 23 and 24 are also rejected for the reasons above.

33. Claims 26 and 27 are drawn to a software system that implements the method drawn in claims 1 and 11. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1 and 11 are rejected, claims 26

Art Unit: 2141

and 27 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

34. Claims 5-9, 13-19, 21, 22, 25, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glass and Uomini as applied to claim 1, 11 above, and further in view of Sundsted (5,999,967).

35. For claim 5, neither Glass nor Uomini discloses an adding unit adding to the electronic signature file a parameter which indicates an importance of the electronic mail. Sundsted teaches a method (see abstract) of e-mail authentication security (col. 1, lines 5-10) in which an electronic stamp is used to show identity (col. 3, lines 25-45), and in which the stamp is attached to the e-mail and acts as a digital signature (col. 11, lines 20-30 in view of col. 7, lines 10-25). This stamp, acting as a signature file, also includes the priority of the message (col. 3, lines 45-52). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

36. For claim 6, neither Glass nor Uomini discloses the parameter indicates the importance of the electronic mail by a display format of the electronic signature file. Sundsted teaches this limitation as well (Fig. 4, #41). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

37. For claim 7, neither Glass nor Uomini discloses that the parameter includes information which indicates a display priority order of the electronic mail. Sundsted teaches this limitation

Art Unit: 2141

(col. 8, lines 30-36). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

38. For claim 8, Uomini discloses that the parameter includes character, image and/or audio information indicating a summary of the electronic mail (col. 2, lines 39-42). At the time the invention was made, one of ordinary skill in the art would have added Uomini to Glass in order to provide a standard mail context study system (col. 1, lines 9-10).

39. For claim 9, neither Glass nor Unomi expressly discloses that the information which indicates the display priority order of the electronic mail includes at least one of a display position and a display timing of the electronic signature file. Sundsted teaches this limitation (col. 10, line 65 – col. 11, line 7). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

40. Claims 13 and 16 are drawn to the limitations in claim 5. Therefore, since claim 5 is rejected, claims 13 and 16 are also rejected for the reasons above.

41. Claim 14 is drawn to the limitations in claims 5 and 6. Therefore, since claims 5 and 6 are rejected, claim 14 is also rejected for the reasons above.

42. Claims 15 and 18 are drawn to the limitations in claim 7. Therefore, since claim 7 is rejected, claims 15 and 18 are also rejected for the reasons above.

43. Claim 17 is drawn to the limitations in claim 9. Therefore, since claim 9 is rejected, claim 17 is also rejected for the reasons above.

Art Unit: 2141

44. Claim 19 is drawn to the limitations in claim 8. Therefore, since claim 8 is rejected, claim 19 is also rejected for the reasons above.

45. Claim 21 is drawn to the limitations in claims 11 and 13. Therefore, since claims 11 and 13 are rejected, claim 21 is also rejected for the reasons above.

46. Claim 22 is drawn to the limitations in claims 1 and 5. Therefore, since claims 1 and 5 are rejected, claim 22 is also rejected for the reasons above.

47. Claim 25 is drawn to the limitations in claims 11 and 14. Therefore, since claims 11 and 14 are rejected, claim 25 is also rejected for the reasons above.

48. Claim 28 is drawn to a software system that implements the method drawn in claims 11 and 14. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 11 and 14 are rejected, claim 28 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Conclusion

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

50. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 2141

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272 - 3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272 - 3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
21 October 2004


LE HIEN LUU
PRIMARY EXAMINER